

*REMARKS*

Claims 13-17, and 24-31 remain pending in the present application, claims 11, 12, and 18-23 having been withdrawn by the Examiner. The Examiner's rejections of all pending claims, in the Final Office Action dated May 6, 2005, are traversed without amendment of any of the pending claims.

CLAIM REJECTIONS UNDER 35 USC § 102

**The rejection of claims 13-15, and 24-27, as being anticipated by Eslambolchi et al. (US 6,349,460), per paragraph 2 of the Office Action, is traversed.**

Claim 13, and Claims 14-17 and 24-31 depending therefrom, require, *inter alia*, an electrician's tool for wiring a building using common routing components, where the tool includes a plate structure for attachment to routing components, with the plate having an aperture formed therein, and the aperture defining an inner edge of the aperture. Two or more rollers are rotatably positioned adjacent to the inner edge, of the aperture, for precluding contact of a wire passing through the aperture with any portion of the inner edge of the aperture. Eslambolchi et al. does not meet these limitations, and cannot, therefore, anticipate claim 13 or any of claims 14-17, or 28-31 depending therefrom.

In paragraph 2 of the Office Action, the Examiner provides only the cursory statement "Eslambolchi discloses 38 with a plate having aperture for four rollers," in support of his rejection of claims 13-15 and 24-27 under 35 USC § 102(e). The Examiner has improperly disregarded the majority of the limitations of claim 13, and all pending claims depending therefrom. Patent claims are to be examined in their entirety. The Examiner's rejection of claims 13-15 and 24-27 as being anticipated by Eslambolchi et al., supported only by the cursory statement of paragraph 2 of the Office Action is therefore incomplete, improper, and should be withdrawn.

Claims 14-15 and 24-27, include additional limitations, which are also totally ignored by the Examiner in his cursory statement, except for the requirement in claims 14 and 15, that the tool must include at least four rollers. The Examiner must examine claims in their entirety, considering all limitations. By his failure to specifically address all of the limitations of claims 14-15 and 24-27, the Examiner has failed to provide any basis for rejection of these claims. The rejection of these claims under 35 USC § 102 should therefore be withdrawn.

### CLAIM REJECTIONS UNDER 35 USC § 103

The following quotations from MPEP § 2143 form the primary basis for traversing all rejections in the Office Action, under 35 U.S.C. § 103(a):

#### **2143 Basic Requirements of a Prima Facie Case of Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

#### **2143.01 Suggestion or Motivation To Modify the References [R-1]**

#### **THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION**

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

#### **FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

**The rejection of claims 16-17 and 28-31, as being unpatentable over Eslambolchi et al. (US 6,349,460), in view of Damron (US 5,271,605) per paragraphs 5 and 6 of the Office Action, is traversed.**

Applicant first notes that the Examiner has not cited any evidence of motivation within the cited references or the level of knowledge of those skilled in the art to which the invention pertains, for combining the teachings of Eslambolchi et al. and Damron. The Applicant specifically notes that these two references appear to come from non-analogous art, with Eslambolchi et al. being directed to installation of fiber optic cables in underground conduits, and Damron being directed to installation of electrical wires in conduit and wiring boxes in the walls of a building. Only Damron appears to be analogous art to the present invention.

In meeting the requirement for citing evidence of motivation for combining references, the Examiner cannot rely solely on conclusory statements, as presented in paragraph 4 of the Office Action. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*, 61 U.S.P.Q. 2d 1430, 1433. The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that the knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

Only by impermissibly working backward from the Applicant's disclosure can the Examiner allege any grounds for asserting the combination of Eslambolchi et al. and Damron. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)(The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

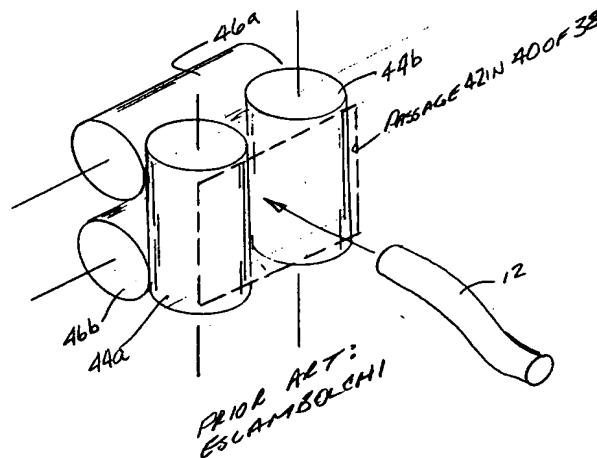
Claims 16-17 and 28-31, all depend from claim 13. As stated above, in relation to traversal of the rejection under 35 USC § 102, the Examiner has not, and indeed cannot, provide a proper basis for rejecting any of the pending claims over Eslambolchi et al., because Eslambolchi et al. standing alone fails to teach or suggest all of the claim limitations required by claim 13 and claims 14-17 and 24-31 depending from claim 13. The Examiner correctly, in paragraph 4 of the Office Action, does not assert that Damron standing alone teaches or suggests all of the claimed limitations of claims 16-17 or 28-31. The combination of Eslambolchi et al. and Damron also does not teach or suggest all of claim 13, and therefore fails to meet the *prima facie* requirements for a case of obviousness for claim 13 or any of claims 16-17 or 28-31 depending from claim 13. *MPEP § 2143. MPEP 2143.03, citing In re Fine, 837 F.2d 1071 (Fed. Cir 1988)(if an independent claim is non obvious under 35 USC 103, then any claim depending therefrom is non-obvious).*

The Applicant specifically notes that Eslambolchi et al. nowhere teaches or suggests that the rollers 44a, 44b, 46a, 46b meet the requirement of claim 13 of the present invention, that "two or more rollers be rotatably positioned adjacent to the inner edge of the aperture for precluding contact of a wire passing through the aperture with any portion of the inner edge of the aperture." It is further noted, that in FIG. 1 of Eslambolchi et al., it appears that only the two vertical edges of the passage 42 in the housing 40 of the pushing mechanism 38 might be said to be protected by the vertical rollers 44a, 44b, in a manner which might preclude contact between the fiber optic cable 12 and the vertical edges of the passage 42. It appears, from FIG. 1 of Eslambolchi et al., that the rollers 44a, 44b, 46a, 46b of Eslambolchi et al. provide no protection against the fiber optic cable 12 coming into contact with the top and bottom edges of the passage 42.

Contrary to the Examiner's assertions at paragraph 4 of the Office Action, Applicant also specifically notes that Eslambolchi et al. does not anywhere teach or suggest that the rollers 44a, 44b, 46a, 46b extend both above and below a plate, as required by claim 17 of the present application.

In general, it appears to the Applicant, that the Examiner has misunderstood and/or misconstrued the teachings of Eslambolchi et al. with regards to the positioning of the rollers 44a, 44b, 46a, 46b in relation to the passage 42. From FIG. 1 of Eslambolchi et al., and the text of the disclosure of Eslambolchi et al., from column 2, line 61, through column 3, line 39, and in particular column 3, lines 4-11 and 33-39, it appears that the four rollers 44a, 44b, 46a, 46b cannot lie in the same plane with one another, and still be capable of closing in to "bear against the periphery of the optical fiber cable 12," as taught by Eslambolchi et al. at

lines 38 and 39 of column 3. It further appears, that the arrangement of the rollers 44a, 44b, 46a, 46b, illustrated in FIG. 1 of Eslambolchi et al., is as shown in the Applicant's sketch below.



It is the Applicant's understanding, based upon a careful reading of the text of Eslambolchi et al., and examination of the figures thereof, that all of the rollers 44a, 44b, 46a, 46b, are positioned inside of the housing 40 and behind the passage 42, with the vertical rollers 44a, 44b being closest to the passage 42, and the horizontal rollers 46a, 46b being displaced behind the vertical rollers 44a, 44b, so that both the vertically oriented set of rollers 44a, 44b and the horizontally oriented rollers 46a, 46b can be moved outward to allow insertion of the casing 18, as taught at column 3, lines 36-37, and thereafter be moved inward to bear against the periphery of the optical fiber cable 12, as taught at lines 37-39 of column 3.

As clearly illustrated in the figure above, the rollers 44a, 44b, 46a, 46b of Eslambolchi et al. do not preclude the cable 12 from coming into contact with the top and/or bottom edges of the passage 42. Because such contact can occur, Eslambolchi et al., does not teach or suggest the required limitation of all pending claims in the application that contact with any portion of the inner edge of an aperture, in a tool according to the invention, be precluded.

### CONCLUSION

The Applicant believes that the application is in condition for allowance, and for the reasons stated above, also believes that the Examiner has not provided a proper basis for a final rejection of the pending claims. Reconsideration and notification of allowance are respectfully requested. Given the incomplete nature of the Office Action, the Applicant further believes that, in the event the Examiner should wish to maintain a rejection on the basis of Eslambolchi et al. and Damron, that the present Final Office Action should be withdrawn, and a new Office Action including proper support for any rejections, be issued, together with a resetting of the time for response.

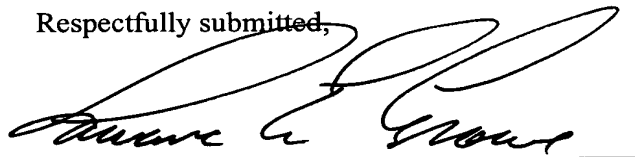
### EXAMINER TELEPHONE CONFERENCE REQUESTED

If, after reviewing the above amendments and remarks, the Examiner does not believe the claims to be allowable, the Applicant requests that the Examiner contact the undersigned Attorney for the Applicant, prior to issuing either an Advisory Action or another Office Action, to arrange for a telephone conference.

### PROCEDURAL MATTERS AND FEES

The Applicant believes that no fees are occasioned by the submittal of this paper. If any fees are occasioned by the filing of this paper, however, the Commissioner is authorized to charge those fees, or credit any overpayments to deposit account 12-1216.

Respectfully submitted,



Lawrence E. Crowe, Reg. No. 35110  
Reinhart Boerner Van Deuren P.C.  
483 N. Mulford Road, Suite 7  
Rockford, Illinois 61107  
(815) 484-1900 (telephone)  
(815) 484-1032 (facsimile)

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